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preparing a transgenic *Caenorhabditis elegans* nematode that expresses a detectable marker linked to *LOV-1* protein;  
mutagenizing the nematode;  
selecting nematodes or offspring thereof that have altered patterns of expression of *LOV-1*; and  
identifying the gene responsible for the alteration.

77. (Amended twice) A method for identifying transcriptional regulators of *lov-1*, comprising:

preparing a transgenic *Caenorhabditis elegans* nematode that expresses a detectable marker linked to *LOV-1* protein;  
mutagenizing the nematode; and  
selecting nematodes or offspring thereof that have altered levels of expression of the protein.

**REMARKS**

Any fees that may be due in connection with this paper or this application may be charged to Deposit Account No. 50-1213. If a Petition for extension of time is needed, this paper is to be considered such Petition.

Claims 1, 5, 9-11, 15-17, 21, 22, 25-32, 42, 49, 74-77 and 82-84 are presently pending in this application. Claims 88 and 89, which are directed to subject matter that is withdrawn from consideration as being drawn to non-elected subject matter, are cancelled without prejudice or disclaimer. Applicant reserves the right to file divisional applications to the non-elected subject matter and continuations to any cancelled subject matter.

Claims 9, 27, 29 and 42 are amended to more particularly point out the subject matter of the claims as required by the Examiner and to place the claims and dependents thereof in condition for allowance. Claims 28, 31, 32, 76 and 77 are amended for typographical and grammatical inconsistencies and errors.

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None of the amendments to the claims have been made in order to overcome art of record.

Claims 21-22, 25-26 and 49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully submits that in light of the traversal of the rejection of base claim 1 and dependents thereon, claim 1 and, hence all claims dependent thereon, including claims 21-22, 25-26 and 49 should be in condition for allowance.

A marked up copy per 37 C.F.R. §1.121 of the amended claims is attached to this response.

**THE REJECTION OF CLAIMS 27-32, 42, 74-77 and 82-84 UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

Claims 27-32, 42, 74-77 and 82-84 are rejected under 35 U.S.C. §112, first paragraph, because the specification, while concededly being enabling for a mutant *C. Elegans* that comprises a mutant *lov-1* gene exhibiting a phenotype of defective mating behavior particularly in the male sensory behaviors response and location of vulva, allegedly does not reasonably provide enablement for transgenic *Caenorhabditis* nematodes comprising a vector encoding the nucleic acid sequence set forth in SEQ ID NO. 3, or any nucleic acid that encodes a mutated LOV-1 protein. The Examiner is not persuaded by Applicant's arguments filed responsive to the Office Action of November 8, 2000, in which Applicant asserted that it would not require undue experimentation to introduce the *C. elegans* *lov-1* gene into a nematode of another *Caenorhabditis* species, and that those of skill in the art knew and recognized the relatedness among species of the genus *Caenorhabditis*.

The Examiner further alleges that while the specification describes the production of *C. elegans* that have been mutagenized and screened for a phenotype of interest there are allegedly has no working examples in the

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specification that correlate introduction and expression of a *lov-1* transgene into a *Caenorhabditis* and a corresponding phenotype that results from transgene expression. Furthermore, the Examiner alleges that the specification provides no working examples that demonstrate identification of genes and regulatory factors involved in polycystic kidney disease using mutagenized *C. elegans*, nor does it show a correlation between a nucleic acid isolated by the same method and polycystic kidney disease.

As discussed below, in the interest of advancing claims to allowance, the rejection on the basis of scope of enablement of any and all transgenic *Caenorhabditis* species is obviated by amendment of claims 27-32 and 42 to recite "*C. Elegans*". The rejection based on lack of enablement of (a) the production of a transgenic *Caenorhabditis* species; and (b) the identification of genes and regulatory factors involved in polycystic kidney disease and a correlation between the nucleic acids isolated by the same method and polycystic kidney disease, is respectfully traversed.

**Relevant law**

To satisfy the enablement requirement of 35 U.S.C § 112, first paragraph, the specification must teach one of skill in the art to make and use the invention without undue experimentation. Atlas Powder Co. v. E.I. DuPont de Nemours, 750 F.2d 1569, 224 USPQ 409 (1984). This requirement can be met by providing sufficient disclosure, either through illustrative examples or terminology, to teach one of skill in the art how to make and how to use the claimed subject matter without undue experimentation. This clause does not require "a specific example of everything *within the scope* of a broad claim." In re Anderson, 176 USPQ 331, at 333 (CCPA 1973), emphasis in original. Rather, the requirements of § 112, first paragraph "can be fulfilled by the use of illustrative examples or by broad terminology." In re Marzocci et al., 469 USPQ 367 (CCPA 1971) (emphasis added).

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**Scope of enablement rejection with respect to the production of any and all transgenic *Caenorhabditis* species**

The Examiner has considered Applicant's arguments filed responsive to the Office Action of November 8, 2000, in which Applicant asserted that the references cited by the Examiner relating to the unpredictability of inter-genera transgenic behavior are not applicable to the intra-genus behavior of closely related *Caenorhabditis* species. The Examiner nevertheless maintains that the instant specification does not enable the production of a transgenic *Caenorhabditis* species.

The Examiner maintains that, absent any relevant teachings or guidance in the specification with regard to the production of any transgenic nematode as claimed, the art of transgenics is unpredictable and varies according to the particular host species and promoter/gene combinations with respect to the site of integration in the host genome, the expression of the transgene, and the resulting phenotype, one of skill in the art would not be able to rely on the state of the transgenic art for an attempt to produce LOV-1 transgenic nematodes. To support this contention, the Examiner again cites the references set forth in the Office Action of November 8, 2000, which include **Wall** (*Theriogenology*, 1996), **Houdebine** (*Journal of Biotechnology*, 1994), **Hammer et al.** (*Journal of Animal Science*, 1986), **Ebert et al.** (*Molecular Endocrinology*, 1988); **Mullins et al.** (*Journal of Clinical Investigations*, 1996), **Kappel et al.** (*Current Opinion in Biotechnology*, 1992) and **Strojek et al.** (*Genetic Engineering*, 1988). The Examiner further alleges that because the transgenic *Caenorhabditis* are not enabled, the claimed methods using transgenic *Caenorhabditis* are not enabled.

It is noted that in the Amendment filed in response to the Office Action mailed November 8, 2000, Applicant provided references (e.g., Review by the *C. Elegans* Sequencing Consortium of the Washington University Genome Sequencing Center (*Science*, 282:2012-2018 (1998); Sommer et al., *Developmental Biology*, 173:396-407 (1996)) demonstrating that nematode species that are related to *C. Elegans* are often used in experimental systems to

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study development at the cellular, genetic and molecular levels, and to predict *C. Elegans* gene structure based on genomic sequence data from related *Caenorhabditis* nematode species. Hence, those of skill in the art are familiar with a variety of nematode species and manipulation of the genes in those species and recognize the relatedness among species of the genus *Caenorhabditis*.

On the other hand, the Examiner has provided no evidence that it is not possible to introduce a gene from one species of nematode into another. The references cited by the Examiner only describe the unpredictability of transgenic behavior as it relates to unrelated inter-genera predictions, not the *intra-genus* behavior of closely related species. Notwithstanding this, in the interest of advancing prosecution of claims to allowance, claims 27-32 and 42 are amended as being directed to transgenic nematodes of the *C. Elegans* species, thereby obviating the rejection with respect to enablement of transgenic *Caenorhabditis* species and methods using transgenic *Caenorhabditis* species.

**Lack of enablement rejection based on the alleged lack of working examples demonstrating transgenic nematodes, identification of genes and regulatory factors involved in polycystic kidney disease, and correlation between a nucleic acid isolated by the same method and polycystic kidney disease.**

The Examiner further alleges that the specification describes the production of *C. elegans* that have been mutagenized and screened for a phenotype of interest; the specification allegedly has no working examples that correlate introduction and expression of a *lov-1* transgene into a *Caenorhabditis* and a corresponding phenotype that results from transgene expression. Furthermore, the Examiner alleges that the specification fails to provide working examples that demonstrate identification of genes and regulatory factors involved in polycystic kidney disease using mutagenized *C. elegans*, nor does it show a correlation between a nucleic acid isolated by the same method and polycystic kidney disease. This rejection is respectfully traversed. As discussed

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in detail below, the specification provides working examples demonstrating a correlation between introduction and expression of a *lov-1* transgene into a *Caenorhabditis* and a corresponding phenotype that results from transgene expression. The specification also provides working examples that, when considered in light of what is known to those of skill in the art, demonstrate the ability to identify genes and regulatory factors involved in polycystic kidney disease using mutagenized *C. elegans*, and to establish a correlation between a nucleic acid isolated by the same method and polycystic kidney disease.

**The specification teaches one of skill in the art to make and use the claimed products and methods without undue experimentation by (a) demonstrating the correlation between introduction and expression of a *lov-1* transgene into a *Caenorhabditis* and a corresponding phenotype that results from transgene expression; (b) demonstrating, in light of what is known to those of skill in the art, the identification of genes and regulatory factors involved in polycystic kidney disease using mutagenized *C. elegans*, and a correlation between a nucleic acid isolated by the same method and polycystic kidney disease.**

**Analysis**

**The scope of the claims**

Claims 27-32 are directed to transgenic *Caenorhabditis elegans* nematodes that contain a vector that contains the nucleic acid encoding the *Caenorhabditis elegans* LOV-1 protein or a mutant thereof that results in altered mating behavior in *Caenorhabditis elegans*.

Claim 42 is directed to a transgenic *Caenorhabditis elegans* nematode, comprising the nucleic acid molecule of claim 15 (*i.e.*, an isolated nucleic acid molecule encoding a mutant *Caenorhabditis* LOV-1 protein which when expressed by a *C. elegans* nematode shows defective Lov and or response mating behaviors).

Claim 74 is directed to a method for identifying genes or regulatory factors involved in polycystic kidney diseases by mutagenizing transgenic *Caenorhabditis elegans* nematodes that contain a dominant negative *lov-1*

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transgene and looking for offspring that demonstrate further loss in function and identifying any additional genes responsible for the loss. Claim 75 specifies that the genes are homologous mammalian genes.

Claim 76 is directed to a method for identifying regulators and factors necessary for synthesis and transport of *LOV-1* protein by preparing a transgenic *Caenorhabditis elegans* nematode that expresses a detectable marker linked to *LOV-1* protein, mutagenizing the nematode, selecting nematodes or offspring thereof that have altered patterns of expression of *LOV-1* and identifying the gene responsible for the alteration.

Claim 77 is a method for identifying transcriptional regulators of *lov-1* by preparing a transgenic *Caenorhabditis elegans* nematode that expresses a detectable marker linked to *LOV-1* protein, mutagenizing the nematode, selecting nematodes or offspring thereof that have altered levels of expression of the marker.

Claims 82-84 are directed to methods for identifying genes and regulatory factors involved in polycystic kidney disease by mutagenizing *Caenorhabditis elegans* nematodes, looking for clumping behavior on a lawn of bacteria, selecting males that do not exhibit clumping behavior, mutagenizing them and looking for restoration of wild-type behavior.

Thus, all of the claims specify that the gene used in the production of a transgenic nematode is a *Caenorhabditis elegans lov-1* gene, and the transgenic nematode is a *Caenorhabditis elegans* nematode. Further, the claims specify the behavior that is altered or restored to wild-type upon mutation of the wild-type or transgenic *C. elegans*.

It is respectfully submitted that it would not require undue experimentation to produce a transgenic *Caenorhabditis elegans* nematode, and to use mutagenized and/or transgenic nematodes in which expression of the *lov-1* gene is modulated to identify genes or regulatory factors involved in polycystic kidney disease.

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**Teachings of the specification**

The specification describes identification and isolation of the *lov-1* gene from *C. Elegans*, the characterization of *lov-1* mutants, wild-type and mutant LOV-1 proteins encoded by the *lov-1* gene and mutants thereof, the discovery of a correlation between *lov-1* gene expression and observable mating behavior phenotypes, and the use of this discovery in methods to identify genes involved in the etiology of polycystic kidney disease.

The instant application describes and exemplifies in great detail methods for isolating nematode genes, for introducing mutations into nematode genes and for preparing transgenic nematode species. For example, Figure 2 and page 31, lines 3-22 of the specification describe the isolation and characterization of the exemplary nematode gene *lov-1* from the *C. elegans* nematode. Page 8, lines 4-8 of the specification describe that genes involved in the polycystic kidney disease pathway may be identified by mutagenizing normal males, selecting offspring that exhibit changes in mating behavior or mating efficiency and identifying the mutated genes. Page 36, lines 11-31 of the specification describe the isolation and characterization of the exemplary *C. elegans* knockout mutant *sy582* using the chemical mutagen EMS, and page 21, lines 34-38; page 36, line 32 to page 37, line 8 of the specification provide the standard methods by which nematode mutants may be obtained.

Further, the specification sets forth in great detail the production of transgenic nematodes. Page 9, lines 2-5 of the specification provides that transgenic nematodes can be produced by any method known to those of skill in the art, including, but not limited to, injection of the nucleic acid into the embryos or cells of the animal, and page 43, lines 1-3 of the specification provides that "precise protocols for culturing and nematodes, producing mutants and transgenics, and for observing behaviors are well known to those of skill in the art". The constructs used to prepare the transgenic nematodes are described, for example, at Figures 2 and 3 of the specification, in EXAMPLE 2 at

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page 54 of the specification, which describes the production of transgenic nematodes carrying nematode-reporter fusion genes, at page 31, lines 3-14 of the specification, and at page 52, line 21 to page 53, line 3 of the specification.

Figure 2 and page 31, lines 3-14 of the specification describes the production of transgenic nematodes using various constructs that either alter the "location of vulva" and "response" behaviors in wild-type ("normal") males, or restore wild-type behavior in mutant nematodes, such as the exemplary mutant nematode *sy552* that has 30% of the "location of vulva" and "response" efficiency of wild-type males:

The *lov-1* gene was cloned by genetic mapping and transformation rescue of the *sy552* behavioral defects (Fig. 2a). *mnDf21/sy552*, *mnDf83/sy552* and *sy552/sy552* males are phenotypically indistinguishable; therefore, *sy552* is reduction or loss of function mutation in *lov-1*. This conclusion is supported by the observed recessive nature of *sy552*. **A 16.9 kb HindIII subclone (plov-1.1) of the cosmid ZK945 rescued response and Lov defects of sy552 (Fig. 2a)**. Both a 6.7 kb HindIII-BamHI fragment from plov-1.1 (plov-1::GFP1) and a 14.1 kb HindIII-StuI frameshift in plov-1.1 (plov-1.3) fail to rescue *sy552* defects (Fig. 2b) yet act in a dominant negative (DN) manner in wild-type males with respect to Lov behavior (Fig. 2c). **Wild-type males expressing either plov-1::GFP or plov-1.3 are Lov defective.** (emphasis added)

Page 48, lines 4-9 of the specification describes transgenic nematodes prepared using the construct plov-1.3 (plov-1.3 encodes a truncated LOV-1 protein lacking the polycystin block 2/channel domain), which has a dominant negative effect in transgenic nematodes affecting only the Lov (location of vulva) behavior and not the Response behavior. Further, as discussed below under "Working Examples", EXAMPLES 1 and 2 of the specification describe the production and use of various transgenic nematodes to study the expression of genes involved in mating behaviors, and the effect of the transgenes on such mating behaviors.

As described in the specification and as discussed with respect to "Knowledge of those of Skill in the Art" below, it is known to those of skill in

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the art that nematodes are a model multicellular organism for studying the function of human genes in normal and disease states. For example, page 23, line 26 to page 24, line 16 of the specification states:

Nematodes, particularly *C. elegans*, is one of the most thoroughly understood of all multicellular organisms. The biology of its nervous system, which contains 302 neurons, is well-documented. Many *C. elegans* genes used have counterparts in mammals, including humans. At least half of the *C. elegans* genes and proteins that have been characterized have structures and functions similar to mammalian genes. These include genes encode enzymes, proteins necessary for cell structure, cell surface receptors and genetic regulatory molecules.

Animals from man to worm have most of their protein families in common and humans frequently have four to five close analogs of a protein family member, where worms have only one. **Essentially all genes and pathways shown to be important in cell-, developmental- and disease-biology have been found to be conserved between worm and human.** This conservation applies to the number and type of protein families, gene structure, the hierarchy of genes in genetic pathways and even gene regulation.

A consequence of this conservation is that human genes can be inserted into the worm genome, to functionally replace the worm genes even in complex cell biological and signal transduction pathways. **Conversely, key worm genes identified using genetics can be used to trigger specific biochemical processes in human cells and to serve as models for the human genes.** (emphasis added)

Therefore, as described in the instant application, nematode genes that show a high degree of homology to the genes involved in human polycystic kidney disease and are associated with an identifiable phenotype such as specific defects in mating behavior may be used to study the polycystic kidney disease pathway, for identifying additional components of the pathway, and for use in drug screening assays to identify compounds affect the pathway and/or compounds that serve as leads for development of drugs for treatment of polycystic kidney disease. The specification also describes that, not only do the *lov-1* and *pkd-2* nematode genes have a high degree of homology to the genes involved in human polycystic kidney disease, but the pathways in which the

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human and nematode genes are involved are similar. For example, page 29, line 28 to page 30, line 11 of the specification provides:

This gene, *lov-1*, encodes a putative membrane protein with a mucin-like, serine-threonine rich amino terminus (Carraway *et al.* (1995) *Trends Glycoscience Glycotechnology* 7:31-44) followed by two blocks of homology to human polycystins encoded by the autosomal dominant polycystic kidney disease (ADPKD) genes (Torres *et al.* (1998) *Current Opinion in Nephrology and Hypertension* 7:159-169). LOV-1 and human PKD1 are 26% identical in block 1. Block 2 also shows 20% identity between LOV-1, all identified polycystins (PKD1, PKD2, and PKDL), and the family of voltage-activated channels (Torres *et al.* (1998) *Current Opinion in Nephrology and Hypertension* 7:159-169). Overall, LOV-1 is the closest *C. elegans* homolog of PKD1. The polycystin/channel domain (block 2) of LOV-1 is required for function. *Lov-1* is specially expressed in adult male sensory neurons of the rays, hook, and head, mediating response, Lov, and potentially chemotaxis to hermaphrodites, respectively (Liu *et al.* *Neuron* 14:79-89, Ward *et al.* (1975) *J. Comp. Neurol.* 160:313-337). **Localization of *lov-1* to neuronal cell bodies and ciliated sensory endings is consistent with a role in either chemo- and/or mechanosensory reception and signaling. Human PKD proteins might similarly be involved in sensory reception during osmoregulation, organogenesis and/or organ maintenance.** (emphasis added)

See also page 40, line 6 to page 41, line 6 of the specification, which provides:

Neither the precise functions of the polycystins nor the molecular basis of kidney cystogenesis is known. **The results provided herein show that the homologs of the polycystins act together in a pathway, that appears to be a signal transduction pathway, in sensory neurons. It has been postulated that human polycystin 1 and polycystin 2 function as an ion channel (Torres *et al.* (1998) *Current Opinion in Nephrology and Hypertension* 7:159-169). Further supporting this conclusion, are the results of others that have indicated that human PKD2 is associated with the activity of a cation channel.** These results were obtained using cell-expression and electrophysiological approaches to examine the potential channel function of a protein called PCL (polycystin-like) that had been identified in the human expressed sequence-tag database by its sequence similarity with PKD2 (Chen *et al.* (1999) *Nature*

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401:383-386). PCL was expressed in *Xenopus oocytes* by microinjecting synthetic mRNA and the channel properties were studied using the two micro-electrode voltage clamp and patch-clamp techniques. It was found that PCL is a non-selective cation channel that is permeable to sodium, potassium and calcium. It is more permeable to calcium. Thus, PCL and PKD2 may be cation-channel subunits.

Hence, as shown herein, PKD1-related proteins act as receptors that regulate the activity PKD2-related proteins. The two proteins are part of a conserved pathway that appears to be a signalling mechanism in which the translocation of ions acts as a second messenger. (emphasis added)

Furthermore, the specification sets forth assays, described below under "Working Examples", that correlate expression of *lov-1* nematode mutants with defective mating behaviors, and assays are set forth demonstrating how such correlation may be used to identify genes that are involved in the etiology of polycystic kidney disease and to provide treatments for polycystic kidney disease. Thus, the specification is fully enabling for the identification of nematode genes with an observable phenotype that provide a model for the study of human polycystic kidney disease, and for the production and/or assay of wild-type, mutagenized and transgenic nematodes that may be used to study the pathway of polycystic kidney disease and possible treatments therefor.

**Level of skill**

The level of skill in this art is recognized to be high (see, e.g., Ex parte Forman, 230 USPQ 546 (Bd. Pat. App. & Int'l 1986)). The numerous articles and patents made of record in this application address a highly skilled audience and further evidence the high level of skill in this art.

**Knowledge of those of skill in the art**

At the time of the effective filing date of this application and before, the skilled artisan knew of standard methods for isolating and characterizing vertebrate homologs of nematode genes. For instance, Bargmann et al., *Science*, 282:2028-2033 (1998), of record in the application's file history, discusses that the *C. Elegans* homologs of highly conserved neuronal genes and

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human disease genes are open to standard methods for isolating mutations and characterizing gene networks by enhancer and suppressor analysis. Bargmann describes numerous examples (e.g., neurotransmitter receptors, neurotransmitter synthesis and release pathways, G protein-coupled second messenger pathways) of *C. elegans* homologs of human genes that are shown to have a similar or identical function in *C. elegans* as they do in human beings. Brenner, *Genetics*, 77:71-94 (1974), also of record in the file history of the instant application, describes methods for the isolation, complementation and mapping of *C. Elegans* mutants. Brenner further describes the value of the simple multicellular organism *C. elegans* in determining the structure of the nervous system. A review by the *C. Elegans* Sequencing Consortium of the Washington University Genome Sequencing Center describes the utility of the complete genomic sequence of *C. Elegans* as a platform for investigating biology (*Science*, 282:2012-2018 (1998); of record in the file history of the instant application; hereinafter "*C. Elegans* Sequencing Consortium Review"). The *C. Elegans* Sequencing Consortium Review highlights the importance, known to those of skill in the art, of using a multi-cellular organism such as *C. Elegans* as a tool for comparison with and interpretation of other genomes, including the human genome (page 2016, column 2). The *C. Elegans* Sequencing Consortium Review also describes that "as expected from evolutionary relationships, there were substantially more protein similarities found between *C. elegans* and *H. sapiens* than between any other cross-species pairwise combination" (page 2014, column 1).

Thus, at the time of filing of the instant application, not only were the methods for isolating nematode genes, for introducing mutations into nematode genes, for preparing transgenic nematodes and for studying the expression of nematode genes known to those of skill in the art, but those of skill in the art had also recognized the value of the exemplary multicellular organism *Caenorhabditis* as a tool to study the genetic organization of other multicellular

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organisms, particularly human beings, and the use of nematodes to identify genes involved in normal and disease conditions in human beings.

**Predictability**

As discussed above with respect to the knowledge of those of skill in the art and the teachings of the specification, the instant application employs standard methods that are known to those of skill in the art to isolate and clone nematode genes, to mutagenize nematodes, to prepare transgenic nematodes, and to study and treat human disease in which homologs and orthologs of nematode genes are implicated.

**Presence of working examples**

The specification provides working examples and descriptions for the production of mutant and transgenic nematodes, and for the use of mutant nematodes and transgenic nematodes in studying the etiology and identifying treatments for polycystic kidney disease. Examples are provided below:

1) EXAMPLE 1 at page 51 of the specification describes the mating behavior and mating efficiency assays that were used to identify the *C. elegans* orthologs of human polycystins, screening for mutants of the same, the genetic mapping of *lov-1* and the production of transgenic nematodes that rescued the defects in mating behavior of *lov-1(sy552)* mutants.

2) EXAMPLE 2 at page 54 of the specification describes the expression analyses of *lov-1* and *pkd-2* genes using *lov-1* or *pkd-2* fusion constructs with suitable reporter genes such as the fluorescent GFP. The fusion constructs were used to prepare transgenic nematodes that were then studied by fluorescence microscopy.

3) page 43, line 5 to page 44, line 29 of the specification describes assays that identify abnormal mating behaviors, particularly the lov and/or response behaviors, that may be used to detect components of the PKD pathway or compounds that affect the PKD pathway.

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4) page 45, lines 1-22 of the specification and elsewhere throughout the specification describe mating efficiency assays used to identify nematodes displaying abnormal mating behaviors.

5) page 46, lines 1-24 of the specification describes the restoration of *lov* and/or response mating behaviors in *lov-1* mutant nematodes using suppressor and enhancer screens.

6) page 46, line 25 to page 47, line 8 of the specification describes the use of sensory assays as another avenue to study the PKD pathway, since *lov-1* and *pkd-2* genes were shown to be expressed in CEM neurons.

7) page 47, line 9 to page 48, line 16 of the specification describes assays using transgenic nematodes that are "dominant negative", i.e., wild-type nematodes are altered using a transgene whose phenotype (e.g., altered mating behavior) is manifested instead of the wild-type phenotype. Such transgenic nematodes are then used to identify mutations and/or compounds that inhibit or otherwise alter PKD function.

8) page 48, line 17 to page 50, line 2 of the specification describes assays to identify regulators and factors necessary for synthesis and transport of LOV-1 and/or PKD-2 proteins, assays for identifying transcriptional regulators of expression of *lov-1* and/or *pkd-2* genes, and a visual assay to identify *lov-1* and *pkd-2* mutant males, which, unlike wild-type males, do not exhibit "clumping" on a bacterial lawn.

### **Conclusion**

As discussed above, the specification provides working examples showing the introduction and expression of a *lov-1* transgene into a *Caenorhabditis elegans* nematode and a corresponding phenotype, namely, altered mating behavior, that results from transgene expression. Further, the specification demonstrates, in light of what is known to those of skill in the art, the use of *C. elegans* as a model multi-cellular organism to study genes involved in human disease. Specifically, in light of what is known to those of skill in the

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art, the specification provides working examples demonstrating the identification of genes and regulatory factors involved in polycystic kidney disease using mutagenized *C. elegans*, and a correlation between a nucleic acid isolated by the same method and polycystic kidney disease. Therefore, in light of the extensive teachings and examples in the specification, the high level of skill of those in this art, the knowledge of those of skill in the art and the breadth of the claims, it would not require undue experimentation for the skilled artisan to make and use the claimed transgenic *Caenorhabditis elegans* nematodes and to practice the claimed methods for the identification of genes and regulatory factors involved in polycystic kidney disease.

**THE REJECTION OF CLAIMS 9-11 UNDER 35 U.S.C. §112, SECOND PARAGRAPH**

Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that applicants regard as the invention. The Examiner maintains that the term "gene" is indefinite because there is allegedly no clear consensus definition in the art accurately delimiting the term "gene" in view of alternative splicing and uncertainties surrounding the metes and bounds of cis-acting elements regulating mRNA expression. The Examiner alleges that although the claims as amended in the response filed May 8, 2000, recite that the gene encodes a LOV-1 protein, the term "gene" also encompasses intron/exon boundaries and promoter regions, which have not been defined by the claims.

It is respectfully submitted that claims 9-11, when read in light of the specification (see "Relevant Law" and "Analysis" below), adequately define the metes and bounds of the term "gene" as used in the claims. The specification provides the *lov-1* gene as defined by its regulatory regions, its intron/exon boundaries, and the LOV-1 protein encoded by the gene.

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As discussed below, claims 9-11 are directed to a specific gene, the *lov-1* gene. Further, as discussed below, the specification defines the intron/exon boundaries, the promoter region and the expressed protein sequence of the *lov-1* gene in great detail.

**Relevant Law**

Claims are not read in a vacuum but instead are considered in light of the specification and the general understanding of the skilled artisan. *Rosemount Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 1547, 221 USPQ 1, 7 (Fed. Cir. 1984), *Caterpillar Tractor Co. v. Berco, S.P.A.*, 714 F.2d 1110, 1116, 219 USPQ 185, 188 (Fed. Cir. 1983). When one skilled in the art would understand all of the language in the claims when read in light of the specification, a claim is not indefinite.

35 U.S.C. § 112, second paragraph requires only reasonable precision in delineating the bounds of the claimed invention. Claim language is satisfactory if it reasonably apprises those of skill in the art of the bounds of the claimed invention and is as precise as the subject matter permits. *Shatterproof Glass Corp. v. Libby-Owens Ford Col.*, 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir.), cert. dismissed, 106 S.Ct. 340 (1985).

The amount of detail required to be included in the claims depends on the particular subject matter and the prior art and is not to be viewed in the abstract, but in conjunction with whether the specification is in compliance with the first paragraph of 35 U.S.C. § 112. If the claims, read in light of the specification, reasonably apprise those skilled in the art of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more:

[i]t is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter (*Bendix Corp. v United States*, 600 F.2d 1364, 1369, 220 Ct. Cl. 507, 514, 204 USPQ 617, 621 (1979); See, also, *Carl Zeiss Stiftung v. Renishaw plc*, 20 USPQ2d 1094, 1101).

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**Analysis**

With respect to claims 9-11, the claimed "gene" is the specific gene that is disclosed in the specification. The specification provides description of this gene, including intron/exon boundaries, coding sequence, and promoter region. Further, the specification sets forth in great detail the definition of the gene that claimed in claims 9-11. For example, SEQ ID No. 3 sets forth the complement (*i.e.*, the non-coding strand) of the *lov-1* gene from *C. elegans*, and SEQ ID No. 4 sets forth the sequence of amino acids of the protein (N-terminus to C-terminus) encoded by the *lov-1* gene. Further, Figure 2 describes the intron-exon boundaries of the *lov-1* gene. As described, for example, at page 31, lines 18-28 of the specification:

Figure 2b illustrates the intron-exon boundaries of the *lov-1* gene. Using RT-PCR with *lov-1* specific primers and *him-5* mRNA, it was found that *lov-1* encodes one transcript corresponding to Genefinder-predicted ORFs, ZK945.10 and ZK945.9 (Fig. 2b), which had been thought to be two genes. *Lov-1* encodes a predicted 3178 amino acid membrane-bound protein (see SEQ ID Nos. 3 and 4) with a serine-threonine rich extracellular domain homologous to mucins (Carraway *et al.* (1995) *Trends Glycoscience Glycotechnology* 7:31-44), a polycystin homology block 1 (26% identity), and a carboxy terminal polycystin block 2 with 20% identity to polycystin proteins 1, 2, and 2, encoded by the PKD1, PKD2, and PKDL (polycystic kidney disease) genes, respectively (Fig. 2d).

See, also, page 34, lines 13-27 of the specification, which states:

Figure 2b illustrates the intron-exon boundaries of the *lov-1* gene. Using RT-PCR with *lov-1* specific primers and *him-5* mRNA, it was As noted above, Figure 2B depicts the *lov-1* genomic structure (exons shown as boxes, introns as lines). With reference to Figure 2B, the coding sequence in the gene set forth in SEQ ID No. 3 (noting that SEQ ID 3 sets forth the non-coding strand) is as follows:

Complement (Join (12500...12685) - Exon A;  
(12266...12451) - Exon B; (12085...12217) - Exon C;  
(11683...11823) - Exon D; (11498...11637) - Exon E;  
(11128...11452) - Exon F; (10268...10899) - Exon G;  
(10138...10216) - Exon H; (9436...9983) - **Exon I**;

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(9312...9392) - **Exon J**; (8685...9262) - **Exon K**;  
(8557...8635) - Exon L; (7830...7997) - Exon M;  
(6774...7786) - Exon N; (6648...6728) - Exon O;  
(6305...6598) - Exon P; (6006...6255) - Exon Q;  
(5732...5958) - Exon R; (4849...5076) - Exon S;  
(4698...4799) - Exon T; (4383...4651) - Exon U;  
(3336...4328) - Exon V; (2229...3094) - Exon W;  
(1976...2181) - Exon X; (1635...1930) - Exon Y;  
(1043...1591) - Exon Z; (625...999) - Exon AA;  
(329...572) - Exon BB; (1...270) - Exon CC).

Further, page 35, lines 1-2 of the specification specifies that the sequence of the LOV-1 protein encoded by the *lov-1* gene is set forth in SEQ ID NO. 4, and Table 3 at page 35 of the specification specifies the location of the intron/exon boundaries of the isolated *lov-1* gene claimed herein with respect to Genbank database submissions of cosmids containing *C. elegans* genomic sequence.

In addition, the specification defines the promoter region of the *lov-1* gene. For example, Figures 3 and 4 and Example 2 of the specification describe the experiments that establish the promoter region of the *lov-1* gene. See, e.g., page 37, lines 9-19 of the specification, which describes that the promoter region directing expression of a *lov-1*-GFP fusion protein is in the region within 2.8 kb of sequence upstream of the *lov-1* gene and 3.9 kb of *lov-1* gene sequence (this 6.7 kb sequence was used to construct the plov-1::GFP1 fusion protein, and it directed expression of the fusion protein in male-specific neurons):

**Expression patterns of *lov-1***

To elucidate the cells in which *lov-1* acts to affect male mating behaviors, the expression pattern of *lov-1*::GFP reporter genes was examined (see Example 2 and Fig. 4). These experiments reveal regulatory regions in the *lov-1* gene. A partial translational fusion containing 2.8 kb of upstream sequence and 3.9 kb of *lov-1* (plov-1::GFP1) directs male-specific expression in male-specific sensory neurons (Fig. 2c and Fig. 4). Conversely, shorter versions of plov-1::GFP1 are not expressed in the same set of male-specific neurons nor

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exclusively in male-specific sensory neurons and do not act as DNs (Fig. 2c).

Further, Example 2 at page 54 of the specification describes that the aforesaid region involved in regulating the expression of *lov-1*, i.e., 2.8 kb of upstream sequence and 3.9 kb of *lov-1* gene sequence is the *Hind*III-*Bam*HI fragment of plov-1.1, described in Figure 2a of the specification as a 16.9 kb *Hind*III subclone of the cosmid ZK945 (Genbank Accession No. Z48544, disclosed at page 36, line 10 of the specification). In addition, Figures 3 and 4 and Example 2 of the specification show that the shorter *Hind*III-*Hpa*I fragment of plov-1.1, used to construct the plov-1::GFP2 fusion protein and containing only the 2.8 kb of upstream sequence without any of the *lov-1* coding sequence does not direct expression of the plov-1::GFP2 fusion protein. Similarly, fusion proteins plov-1::GFP3, constructed using a *Sac*I (Klenow filled-in and religated) deletion of plov-1::GFP1 that contains about 1 kb of upstream sequence and the sequence containing exons G through K of *lov-1*; and plov-1::GFP4, constructed using a *Hind*III-*Hpa*I (Klenow filled-in and religated) deletion of plov-1::GFP1 that is the sequence containing exons A through K of *lov-1* and none of the upstream sequence, are not expressed. Thus, the specification describes that the *lov-1* promoter sequence is (i) within the region containing 2.8 kb of sequence upstream of the *lov-1* gene and 3.9 kb of sequence containing exons A through K of the *lov-1* gene; and (ii) the *lov-1* coding sequence containing exons A through K alone, the 2.8 kb upstream sequence alone, or 1 kb of upstream sequence combined with the sequence containing exons G through K of the *lov-1* gene are insufficient to direct gene expression of the fusion constructs.

The experiments above demonstrate that when the 2.8 kb sequence upstream of the *lov-1* gene is present 5' of the *lov-1* gene, expression is obtained. As discussed above, all of the sequence information pertaining to the intron/exon boundaries, the coding sequence, and the expression-regulating promoter and other sequences of the *lov-1* gene are described and/or are incorporated by reference in the specification. Accordingly, it is respectfully

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submitted that in light of the specification and what is known to those of skill in the art, the term "gene" as used in claims 9-11 to define a gene encoding a LOV-1 protein includes the promoter and the intron/exon boundaries, and is therefore not indefinite. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

**THE REJECTION OF CLAIMS 1, 5, 7, 9-11 and 15-17 UNDER 35 U.S.C. § 102**

Claims 1, 5, 7, 9-11 and 15-17 are rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Wilson et al., (Nature 368:32-38, 1994) for reasons of record. The Examiner alleges that although Applicant has argued that Wilson does not disclose the nucleotide sequence set forth in SEQ ID NO. 3, nor the 3178 amino acid LOV-1 protein, nor the coding regions and intron/exon boundaries of *lov-1*, the rejection is maintained because Wilson allegedly discloses a sequence that has 100% local similarity to the nucleotide sequence set forth in SEQ ID NO. 3. The Examiner contends that since the sequence of Wilson and SEQ ID NO. 3 allegedly share 100% local similarity, the sequence of Wilson comprises that of SEQ ID NO. 3. The Examiner further contends that since the sequence of Wilson allegedly shares 100% identity with that of SEQ ID NO. 3, it is inherent that the sequence of Wilson encodes the same amino acid sequence as that encoded by SEQ ID. NO. 3, and, furthermore, that the Wilson sequence and SEQ ID NO. 3 will hybridize to each other. This rejection is respectfully traversed. It is respectfully submitted that this rejection is rendered moot with respect to Claim 7, which was cancelled in the Amendment filed May 8, 2001.

**Relevant law**

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. In re Spada, 15 USPQ2d 1655 (Fed. Cir., 1990), In re Bond, 15 USPQ 1566 (Fed. Cir. 1990), Soundscriber Corp. v. U.S., 360 F.2d 954, 148 USPQ 298, 301, adopted 149 USPQ 640 (Ct. Cl.)

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1966. See, also, Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir.), cert. denied, 110 S.Ct. 154 (1989). "[A]ll limitations in the claims must be found in the reference, since the claims measure the invention". In re Lang, 644 F.2d 856, 862, 209 USPQ 288, 293 (CCPA 1981). Moreover it is incumbent on Examiner to identify wherein each and every facet of the claimed invention is disclosed in the reference. Lindemann Maschinen-fabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Further, the reference must describe the invention as claimed sufficiently to have placed a person of ordinary skill in the art in possession of the invention. Prior art does not anticipate a thing or process unless it is enabling; an anticipatory publication must describe the claimed invention with sufficient clarity and specificity so that one skilled in the relevant art could practice the subject matter of the patent without assistance from the patent claimed to have been anticipated Columbia Broadcasting System v. Sylvania Elec. Products, Inc., 415 F.2d 719, 735, 162 USPQ 577 (1st Cir. 1968) cert. denied, 396 U.S. 1061, 164 USPQ 321 (1970).

"Before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." Titanium Metals Corp. v Mossinghoff, 603 F.Supp. 87, 0, 225 USPQ 673 (1984) quoting In re Application of Le Grice 49 CCPA 1124, 301 F.2d 9333

**The claims**

Claim 1 is directed to an isolated nucleic acid molecule comprising a sequence of nucleotides selected from among (a) a sequence of nucleotides encoding a *Caenorhabditis* nematode LOV-1 protein and encoding the sequence of amino acids encoded by the complement of the sequence set forth in SEQ ID NO. 3; (b) a sequence of nucleotides that is the complement of a sequence of

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nucleotides set forth in SEQ ID. NO 3 and that encodes a *Caenorhabditis* LOV-1 protein, or a complement thereof; (c) a sequence of nucleotides that encodes a *Caenorhabditis lov-1* gene and that hybridizes to at least one of the exons of SEQ ID NO. 3 under conditions of at least moderate stringency and is present in a *Caenorhabditis* nematode genome, or (d) a degenerate nucleotide sequence of SEQ ID NO. 3, and a *C. Elegans* nematode expressing the protein exhibits normal location of vulva and response sensory behaviors. Claim 5 is directed to the nucleic acid molecule of claim 1 that encodes the amino acid sequence set forth in SEQ ID NO. 4. Claim 9 is directed to an isolated gene comprising the nucleic acid molecule of claim 1, and claims 10-11 further define the isolated gene of claim 9 as comprising homologous or heterologous transcriptional control elements. Claims 15-17 are directed to isolated nucleic acid molecules that encode mutant forms of the protein encoded by the molecule of claim 1 where a *Caenorhabditis elegans* expressing such mutant protein exhibits an alteration in one or both of the location of vulva and/or response phenotype.

**Differences between the disclosure of Wilson et al. and the claimed subject matter**

Wilson et al. discloses *Caenorhabditis elegans* clones from chromosome III, and the GENEFINDER-predicted open reading frames therein. The GENEFINDER program employed in the disclosure of Wilson only identifies likely genes of chromosome III, based on a comparison of the sequence data set forth in Wilson with public sequence databases. Wilson does not disclose the isolated genes, nor mutants thereof, claimed in the instant application, which are genes from chromosome II of C. Elegans. The Examiner's sequence search provided with the previous Office Action mailed November 8, 2000, is the sequence of nucleotides corresponding to the *C. elegans* cosmid ZK945, which contains *C. elegans* genomic sequence from chromosome II of *C. elegans* (see Genbank sequence submission, attached hereto).

The genomic sequence of the *C. elegans* cosmid ZK945 does not have 100% local sequence similarity to that set forth in SEQ ID NO. 3. The ZK945

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Genbank sequence data provides only 12,222 bases of the sequence set forth in SEQ ID NO. 3. SEQ ID NO. 3 contains genomic sequence from more than one cosmid: 12,222 bases of sequence from cosmid ZK945 comprising exons C through Z and exon AA-CC of the *lov-1* gene, and the remainder from cosmid F27E5 comprising exons A and B of the *lov-1* gene, for a total of 12,685 bases of sequence as set forth in SEQ ID NO. 3. The ZK945 sequence does not comprise the entire sequence set forth in SEQ ID NO. 3, nor the entire coding sequence of the *lov-1* gene as discovered and claimed in the instant application. SEQ ID NO. 3 contains additional sequence comprising some of the exons of the *lov-1* gene that is not present in the cosmid ZK945.

The 12,222 bases of the *C. elegans* cosmid ZK945 sequence data that is 100% similar to part of the sequence set forth in SEQ ID. NO. 3 does not anticipate all of the elements of claim 1, nor of its dependent claims because: (a) it does not contain all of the genomic sequence or coding sequence comprising the *lov-1* gene that is set forth in SEQ ID NO. 3; (b) it does not encode the sequence of amino acids encoded by the complement of the sequence of nucleotides set forth in SEQ ID NO. 3 because it does not contain all of the coding sequence set forth in SEQ ID NO. 3; (c) it is not the complement of the sequence of nucleotides set forth in SEQ ID NO. 3. Furthermore, since the reference does not disclose the full-length sequence of the gene nor any utility or associated phenotype it does not meet limitations (c) or (d) of claim 1.

Furthermore, the cited reference does not provide a utility for the sequences disclosed therein; such showing is required for a reference to be novelty defeating. No use is provided for any sequence.

The GENEFINDER program employed in the disclosure of the Genbank sequence data submission for cosmid ZK945 only identifies likely genes, based on a comparison of the ZK945 sequence data with other publicly available sequence data. At the time of the Genbank sequence submission of the ZK945

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sequence data and prior to the isolation of the *lov-1* gene as claimed in the instant application, the GENEFINDER program predicted two separate genes: "ZK945.9" and "ZK945.10". It was the actual isolation and characterization of the *lov-1* gene as claimed in the instant application that led to the discovery that *lov-1* encodes a single transcript corresponding to the GENEFINDER-predicted open reading frames "ZK945.9" and "ZK945.10". As shown in the instant application, the intron/exon boundaries of isolated genes are not identical to that predicted by computer analysis of the genomic clones in the databases. The cosmid that has 100% local similarity does not encompass the entire *lov-1* gene.

As shown and stated in the application (page 33):

SEQ ID NO. 3 is the complement of the genomic sequence of the *lov-1* gene. It includes open reading frames (ORFs) between nucleotides 15760 to 27880 of cosmid ZK945 (nucleotides 1 to 12121 of SEQ ID NO.3) and nucleotides 1-564 of cosmid F27E5 (nucleotides 12122 to 12685 of SEQ ID NO.3). It was found herein, however, that ZK945 and F27E5 overlap from nucleotides 27881 to 27981 and nucleotides 1 to 101, respectively (the overlap region includes nucleotides 12122 to 12222 in SEQ ID NO.3), thereby providing a single, rather than two, ORFs (emphasis added).

Figure 2b illustrates the intron-exon boundaries of the *lov-1* gene and TABLE 3 provides a summary of their locations with reference to the Sequence Listing. Using RT-PCR with *lov-1* specific primers and *him-5* mRNA, it was found that *lov-1* encodes one transcript corresponding to Genefinder-predicted ORFs, ZK945.10 and ZK945.9 (Fig. 2b), which had been thought to be two genes. *Lov-1* encodes a predicted 3178 amino acid membrane-bound protein (see SEQ ID Nos. 3 and 4) with a serine-threonine rich extracellular domain homologous to mucins (Carraway *et al.* (1995) *Trends Glycoscience Glycotechnology* 7:31-44), a polycystin homology block 1 (26% identity), and a carboxy terminal polycystin block 2 with 20% identity to polycystin proteins 1, 2, and 2, encoded by the PKD1, PKD2, and PKDL (polycystic kidney disease) genes, respectively (Fig. 2d).

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Furthermore, exons I, J and K were not predicted by GENEFINDER but were identified in the isolated *lov-1* gene (see specification at page 33, line 20 to page 34, line 12), showing that *lov-1* encodes a single transcript rather than what was predicted to be two transcripts. As shown in the application (see, e.g., pages 32 to 35), it was found that *lov-1* encodes one transcript corresponding to Genefinder-predicted ORFs, ZK945.10 and ZK945.9 (Fig. 2b), which had been thought to be two genes:

DNA sequence analysis of RT-PCR generated cDNA clones from *him-5(e1490)* RNA revealed three exons (exons I, J and K in Figure 2B) in the junction between ZK945.10 and ZK945.9: one from nucleotides 25195 to 25742 of the ZK945 cosmid (nucleotides 9436 to 9983 of SEQ ID NO. 3); a second from nucleotides 25071 to 25151 of the ZK945 cosmid (nucleotides 9312 to 9392 of SEQ ID NO. 3); and a third initiating at position 25021 in the ZK945 cosmid (nucleotide 9262 of SEQ ID NO. 3). This demonstrated that the *lov-1* gene encodes one large transcript corresponding to ORFs in ZK945.10 and ZK945.9, spanning what had previously been thought to encode two proteins.

*Lov-1* encodes a predicted 3178 amino acid membrane-bound protein that is not described in the Wilson disclosure. The ZK945 sequence data does not describe a single ORF that encodes a 3178 amino acid protein. Hence, the Genbank sequence submission does not provide the *lov-1* gene nor suggest the instantly claimed gene. Therefore, the GENEFINDER-predicted open reading frames disclosed in the Genbank sequence submission of the *C. elegans* cosmid ZK945 do not constitute the isolated nucleic acid molecules claimed in the instant application.

Neither the Wilson reference nor the Genbank sequence data for ZK945 discloses the isolated genes, or mutants thereof, claimed in the instant application. Furthermore, the sequence information set forth in Wilson and the Genbank ZK945 sequence submission does not teach or suggest a mutation in the sequence that results in a gene that when expressed in a nematode results in altered mating behavior. Neither the Wilson disclosure nor the Genbank

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sequence data for *C. elegans* cosmid ZK945 provides any insights regarding the function of the *lov-1* gene, nor do they teach or suggest any mutations thereof.

As discussed above, Wilson does not provide any sequence data for the *lov-1* (on chromosome II) genomic sequence; Wilson only provides sequence data from chromosome III of *C. elegans*. Further, the Genbank sequence data from *C. elegans* cosmid ZK945 does not disclose the sequence set forth in SEQ ID NO. 3, nor the *lov-1* coding sequence, nor a utility for the *lov-1* gene.

Therefore, since anticipation requires that a reference teach all elements as claimed and must provide a utility for a product, neither Wilson *et al.* nor the Genbank sequence data for cosmid ZK945 anticipate any of claims 1, 5, 9-11 and 15-17.

\* \* \*

In view of the above amendments and remarks, reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,  
HELLER EHRMAN WHITE & McAULIFFE LLP

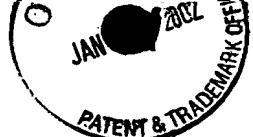
By:

Stephanie L. Seidman  
Registration No. 33,779

Attorney Docket No. 18021-2919

**Address all correspondence to:**

HELLER EHRMAN WHITE & McAULIFFE LLP  
4350 La Jolla Village Drive, 6th Floor  
San Diego, CA 92122  
Telephone: 858 450-8400  
Facsimile: 858 587-5360  
email:sseidman@HEWM.com



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sternberg *et al.*

Serial No.: 09/479,467

Filed: January 06, 2000

For: POLYCYSTIC KIDNEY DISEASE GENE  
HOMOLOGS REQUIRED FOR MALE  
MATING BEHAVIOR IN NEMATODES  
AND ASSAYS BASED THEREON

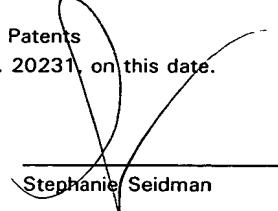
Group Art Unit: 1632

Examiner: P. Paras, Jr.

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10/26/01  
Date

  
Stephanie Seidman

**MARKED UP CLAIMS (37 C.F.R. § 1.121)**

Please amend claims 9, 27, 28, 29, 31, 32, 42, 76 and 77 as follows:

9. (Amended twice) An isolated gene, comprising the nucleic acid molecule of claim 1 that encodes a *Caenorhabditis elegans* [nematode] LOV-1 protein and that comprises the sequence of amino acids set forth in SEQ ID No. 4, comprising the nucleic acid molecule of claim 1].

27. (Amended twice) A transgenic *Caenorhabditis elegans* species nematode, comprising the vector of claim 26.

28. (Amended) The transgenic nematode of claim 27, wherein [in] the vector is maintained [extrachromosomally] extrachromosomally.

29. (Amended twice) The transgenic nematode of claim 27, wherein[: the nematode is *Caenorhabditis elegans* (*C. elegans*); and] the vector or a gene-encoding portion is integrated into the *C. elegans* genome.

31. (Amended twice) The transgenic nematode of claim 27, wherein: the nucleic acid molecule encodes a mutant *LOV-1* protein; a nematode expressing the mutant protein exhibits defective mating behavior; and

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STERNBERG *et al.*  
AMENDED CLAIMS

a nematode that expresses such defect exhibits one or both of an altered location of vulva (Lov) and response phenotype.

32. (Amended twice) The transgenic nematode of claim 30, wherein:  
the nucleic acid molecule encodes a mutant *LOV-1* protein;  
a nematode expressing the mutant protein exhibits defective mating behavior; and

a nematode that expresses such defect exhibits one or both of an altered location of vulva (Lov) and response phenotype.

42. (Amended twice) A transgenic *Caenorhabditis elegans* nematode, comprising the nucleic acid molecule of claim 15.

76. (Amended twice) A method for identifying regulators and factors necessary for synthesis and transport of *LOV-1* protein[;], comprising:  
preparing a transgenic *Caenorhabditis elegans* nematode that expresses a detectable marker linked to *LOV-1* protein;  
mutagenizing the nematode;  
selecting nematodes or offspring thereof that have altered patterns of expression of *LOV-1*; and  
identifying the gene responsible for the alteration.

77. (Amended twice) A method for identifying transcriptional regulators of *lov-1*, comprising:

preparing a transgenic *Caenorhabditis elegans* nematode that expresses a detectable marker linked to *LOV-1* protein;  
mutagenizing the nematode; and  
selecting nematodes or offspring thereof that have altered levels of expression of the protein.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sternberg *et al.*

Serial No.: 09/479,467

Filed: January 6, 2000

For: POLYCYSTIC KIDNEY DISEASE  
HOMOLOGS REQUIRED FOR MALE MATING  
BEHAVIOR IN NEMATODES AND ASSAYS  
BASED THEREON

Art Unit: 1632

Examiner: P. Paras, Jr.

I hereby certify that this paper and the attached papers are being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents,  
Washington, D.C. 20231, on this date.

10/26/01

Date

Stephanie Seidman

**ATTACHMENT TO RESPONSE TO OFFICE ACTION**

1. Supporting reference:

*C. elegans* cosmid ZK945, complete sequence from GenBank  
database (Accession No. Z48544)



FEATURES	Location/Qualifiers
source	1..27981 /organism="Caenorhabditis elegans" /db_xref="taxon:6239" /chromosome="II" /clone="ZK945"
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